

**REMARKS**

Claims 1-25, 27-53, and 55-62 are pending in this application. Claims 1, 5-8, 18, 31, 34-38, 46, and 59-62 are amended. Support for the amendments is found throughout the U.S. Patent Application No. 09/964,390. No new matter is submitted. Accordingly, entry and consideration of this Amendment is respectfully requested.

Assignee acknowledges that Items 1 and 2 of the Office Action refer generally to Title 35, U.S.C. citations and Amendments set forth in prior Office Actions relative to this application.

**35 U.S.C. §112 Rejections**

In Items 3 and 4 of the Office Action, claims 1 and 18 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph for alleged lack of antecedent basis for “the subscriber”. Assignees assert however that antecedent basis for “the subscriber is amply provided by the recitation of “a subscriber” in claim 1, lines 1-2, and by the recitation of “a subscriber’s” in claim 18, line 3, respectively. Accordingly, withdrawal of the 35 U.S.C. §112, 2<sup>nd</sup> paragraph rejection of claims 1 and 18 based on any alleged lack of antecedent basis is respectfully requested.

In Items 3 and 5 of the Office Action, claims 1, 18, 31 and 46 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph as allegedly indefinite for use of the terms “user”, “subscriber”, “calling party” and “called party”. In view of U.S. Patent Application No. 09/964,390, paragraphs [0013] and [0015], for example, Assignee asserts that the terms “user” and “calling party” are readily understood by one skilled in the art as representing that party from whom a telephone call originates. Based on the same paragraphs, Assignee further asserts that the terms “subscriber” and “called party” are readily understood by one skilled in the art as that party to whom a call is destined. Nevertheless, claims 1, 18, 31 and 46 are amended herein to recite “caller” and “subscriber”, where appropriate, in order to obviate the alleged indefiniteness. Claims 5-8, 34-38 and 59-62 are also amended consistent therewith and to clarify that the access directory number may comprise at least one subscriber number. The various levels of

access provided by the access directory number are described in U.S. Patent Application No. 09/964,390 at paragraph [0017], for example. Accordingly, any alleged indefiniteness having been obviated by the amendments made herein, withdrawal of the 35 U.S.C. §112, 2<sup>nd</sup> paragraph rejection of claims 1, 18, 31 and 46 is respectfully requested.

### **Rejection of Claims under § 103(a) / Moss Reference**

In Item 6 of the Office Action, claims 1-4, 18-22, 31-33, 36, and 47-50 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 7,016,482 to Moss, et al. (hereafter "Moss"). The rejection is respectfully traversed.

### **Assignee's Claimed Subject Matter**

Assignee's independent claims 1, 18, 31, and 46 are set forth above and recite either a method or system for providing enhanced caller information to a subscriber using an advanced intelligent network. All other claims depend directly or indirectly from one of said independent claims.

Each of independent claims 1, 18, 31 and 46 further generally recite that a server receives a plurality of caller profiles. The caller profiles include an access directory number and at least one enhanced caller information. *See*, U.S. Patent Application No. 09/964,390, paragraph [0017]. The enhanced caller information is *in addition* to standard caller number and caller name information and is provided to the subscriber from the server *at the request* of the subscriber. *See*, U.S. Patent Application No. 09/964,390, paragraphs [0006], [0007] and [0013]. The access directory number that is set by the caller thus controls the level of caller information that is provided to the server, but it is the subscriber that determines if the enhanced caller information is requested from the server.

Referring still to independent claims 1, 18, 31 and 46, each further recites that when a call to a subscriber is made, a service switching point trigger causes a query to be sent to a service control point. In response to the query, a message is sent from the service control point to the server. The message comprises the caller number and the subscriber number. The caller number is then matched, at the server, to the access directory number. If the subscriber accesses the server, then the enhanced caller information is made available to the subscriber. *See*, U.S. Patent Application No. 09/964,390, paragraphs [0023] and [0025]. Otherwise, only standard caller information, *i.e.*, caller name and caller number, is provided to the subscriber. A subscriber may access such enhanced caller information from any computer, network or telephony device. *See*, U.S. Patent Application No. 09/964,390, paragraphs [0019] and [0026-0028]. The enhanced caller information, as cited in the claims, is understood to comprise multi-media content files such as web sites, business cards, photos, advertising, or other information. *See*, U.S. Patent Application No. 09/964,390, paragraphs [0013] and [0016].

### **Lack of Obviousness**

To establish a *prima facie* case of obviousness, three criteria must be met:

- I) the prior art must provide “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”;
- II) there must be a reasonable expectation of success; and
- III) all the claimed limitations must be taught or suggested by the prior art.

*See*, DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”).

Each of the above criteria are addressed in turn below, whereby the Assignee demonstrates that Moss does not render obvious the Assignee’s claimed subject matter as Moss does not teach, suggest, or otherwise provide motivation to produce the claimed subject matter. Further, Moss does not provide a reasonable expectation of success. Still

further, Moss does not disclose, teach, and/or otherwise suggest the claimed subject matter of independent claims 1, 18, 31, and 46.

I. Moss discloses a caller identification system (20) that identifies and displays a calling party's name for calls placed to destination numbers within the same organization. *See*, U.S. Patent No. 7,016,482, col. 2, lines 32-34. Moss also discloses that for calls directed to destination numbers outside the organization, then only the organization's name is identified and displayed. *Id.*, col. 2, lines 34-37. Thus, in order to have the specific name of a calling party identified and displayed in Moss, the destination number must be part of the same network as the calling party, *i.e.*, must be part of the calling party's organization network. *Id.*, col. 2, lines 42-45. In order to access a custom name database (32) that provides the specific name of a caller within the same organization, Moss requires that "...service switching point (SSP) 22 has a plurality of destination numbers 24" (*Id.*, col. 2, lines 12-14) that sends queries via a service control point (26) to the custom name database (32) (*Id.*, col. 2, lines 32-45). Otherwise, only the standard name database (30) is queried and only the organization's name is identified and displayed (30). *Id.*, col. 2, lines 20-26. Thus, all Moss stands for is that a specific calling party's name and number, and the date and time of the call, are identified, and this occurs only if a custom name database (32) is queried based on destination numbers within a common organization, that are pre-entered into a service switching point (22). Nothing in Moss teaches or suggests that enhanced caller information is provided or available to a called party. Thus, notwithstanding assertions in the Office Action to the contrary, Moss does not teach, disclose or otherwise suggest the claimed subject matter including a server that is accessed by a subscriber to request retrieval of enhanced caller information, nor does Moss teach, disclose or otherwise suggest the standard name and number caller information, as is recited in each of Assignee's independent claims. Further, Moss provide any motivation to do so because Moss discloses only name and custom name databases (30) and (32), respectively, that are automatically triggered based on inputted destination numbers rather than by the subscriber's (called party's) specific request in addition to the standard calling information. Accordingly, withdrawal of the 35 U.S.C.

§103(a) rejection of claims 1-4, 18-22, 31-33, 36 and 47-50 based on Moss is respectfully requested.

II. Because Moss discloses that destination numbers in a common organization be provided in a service switching point (22) in order to query a custom name database (32) and authorize display of a specific calling party's name, then Moss does not disclose a system that, upon request from a subscriber, provides enhanced caller information via a server that is accessible to subscribers outside of the common organization, as recited in the claimed subject matter of independent claims 1, 18, 31, and 46. In fact, to the extent that Moss provides only name and custom name databases (30) and (32), respectively, *i.e.*, not enhanced caller information as in Assignee's claims, then Moss actually teaches away from providing enhanced caller information to a subscriber in any event.

"A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See*, MPEP at §2145 (X)(D)(1). If the proposed reference(s) changes the principle of operation of the prior art, then the teachings of the reference are not sufficient to support a *prima facie* case of obviousness. *Id.* at §2143.01.

In this instance, Moss identifies at best name or custom name only, but does not provide enhanced calling information from a server accessible by non-organizational subscribers as cited in Assignee's independent claims. Nor is there any reasonable expectation of successfully modifying Moss to provide such enhanced caller information as adding such enhanced caller information would material alter the principal operation of Moss, which is to provide only the name of the organization, or the specific name of a calling party within the organization, based on pre-entered destination numbers in a service switching point.

Thus, Moss does not render obvious the subject matter recited in at least Assignee's independent claims 1, 18, 31 and 46. Accordingly, withdrawal of the 35

U.S.C. §103(a) rejection of claims 1-4, 18-22, 31-33 and 47-50 based on Moss is respectfully requested.

III. Moss fails to teach or suggest a server having caller profiles with enhanced caller information, which server is accessible by subscribers outside of a common organization, whereby the enhanced caller information, in addition to the standard caller information, is retrieved from the server upon request of the subscriber, as cited in each of Assignee's independent claims 1, 18, 31 and 46. Thus, Moss does not render obvious the subject matter recited in at least Assignee's independent claims 1, 18, 31 and 46. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 1-4, 18-22, 31-33 and 47-50 based on Moss is respectfully requested.

#### **Rejection of Claims under § 103(a) / Moss & Gurbani References**

In Item 7 of the Office Action, claims 11-17, 27-30, 41-46 and 55-62 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Moss in view of U.S. Patent No. 6,282,275 to Gurbani, et al. (hereafter "Gurbani"). The rejection is respectfully traversed.

#### **Assignee's Claims**

Assignee's independent claims 1, 18, 31 and 46, from one of which all remaining claims ultimately depend, are set forth and discussed above.

#### **Lack of Obviousness**

To establish a *prima facie* case of obviousness, three criteria must be met:

- I) the prior art must provide "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill";

- II) there must be a reasonable expectation of success; and
- III) all the claimed limitations must be taught or suggested by the prior art.

See, DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

Each of the above criteria are addressed in turn below, whereby the Assignee demonstrates that the combination of Moss and Gurbani does not render obvious the Assignee's claimed subject matter as the combination does not teach, suggest, or otherwise provide motivation to produce the claimed subject matter. Further, the combination does not provide a reasonable expectation of success. Still further, the combination does not even disclose, teach, and/or suggest all of the claimed subject matter.

I) Moss is discussed in detail above and generally provides a caller identification system (20) that identifies specific caller names from a custom name database (32) if a pre-entered destination number within a common organization has been called. See, U.S. Patent No. 6,282,275, col. 2, lines 32-45. Otherwise, Moss identifies only the organization's name from a standard name database (30). Id., col. 2, lines 20-24. The destination numbers (24) are pre-entered into service switching point (22) in Moss and trigger queries, via service control point (26) to the appropriate name database (30) or custom name database (32) based on the destination numbers pre-entered into the service switching point (22). Id., col. 2, lines 20-24 and lines 32-45. Nothing in Moss teaches or suggests that the caller information provided from the standard name database (30) or the custom name database (32) includes enhanced caller information in addition to the standard information provided from such databases. As a result, Moss also necessarily fails to teach or suggest that a subscriber may request the retrieval of such enhanced caller information. Further, the custom name information in Moss is only available in response to a call to a destination number within a common organization, rather than through a server that is accessible, upon request, to subscribers outside a common organization, as is contemplated by Assignee's claims.

Gurbani, meanwhile, discloses storing caller identification as a log of answered and unanswered calls on a server (124) that is accessible to a called subscriber (Abstract). The server (124) receives, time stamps and stores the caller information for the called subscriber. *Id.*, col. 2, lines 59-63. The caller information stored in the server (124), and accessible to an authenticated subscriber, includes the time of the call time, the caller number (if not blocked), and the caller name (if available). *Id.*, col. 3, lines 39-50. Once the subscriber retrieves this information, the subscriber can prioritize the information as they wish. *Id.*, col. 3, lines 48-50; *see also*, Fig. 2 for representative log of prioritized calls. Gurbani thus discloses a means of logging standard caller name, number, date and time information, and rearranging such information if desired. Notably, Gurbani nowhere teaches or suggests providing enhanced caller information that is accessible to a subscriber at a subscriber's request, as claimed in each of Assignee's independent claims.

Because neither Moss nor Gurbani, singly or in combination, teaches or suggests enhanced caller information, nor the accessing thereof at a subscriber's (called party's) request, then neither provides motivation to do so either. Accordingly, the combination of Moss and Gurbani does not render obvious the claimed subject matter of Assignee's independent claims 1, 18, 31 and 46, from one of which claims 11-17, 27-30, 41-46 and 55-62 depend. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claims 11-17, 27-30, 41-46 and 55-62 based on the combination of Moss and Gurbani is respectfully requested.

II) Because Moss limits the identification of caller information that is identified to standard name or custom name information only, then Moss teaches away from providing the enhanced calling information recited in Assignee's independent claims. Likewise, because Gurbani limits the logs of stored calls to standard caller name, number, date and time information, then Gurbani also teaches away from providing the enhanced calling information recited in Assignee's independent claims.



“A reference that ‘teaches away’ from the claimed invention is a significant factor” when determining obviousness. *See*, MPEP at §2145 (X)(D)(1). “It is improper to combine references where the references teach away from their combination.” *Id.* at § 2145 (X)(D)(2). If the proposed reference(s) changes the principle of operation of the prior art, then the teachings of the reference are not sufficient to support a *prima facie* case of obviousness. *Id.* at §2143.01.

Moss and Gurbani limit identification of caller information to a caller name, number, date and time information. That Moss alternatively provides a custom caller name database (32) is still simply the identification of name, number, date and time information. The option of a subscriber additionally specifically requesting enhanced caller information, as cited in each of Assignee’s independent claims, is nowhere disclosed or otherwise suggested in either of Moss or Gurbani. Thus, neither Moss nor Gurbani provide any reasonable expectation that their systems or methods could successfully be modified singly, or in combination, to provide the combination of Assignee’s claimed subject matter. In fact modifying either or both of Moss and Gurbani to also provide enhanced caller information would alter the principal operation of them – that is, the principal operation is intended to limit the caller identification to the name (custom name), number, date and time information disclosed therein, respectively.

Thus, the combination of Moss and Gurbani does not render obvious the subject matter recited in at least Assignee’s independent claims 1, 18, 31 and 46. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 11-17, 27-30, 41-46 and 55-62 based on the combination of Moss and Gurbani is respectfully requested.

III) Moss discloses a caller identification system that identifies standard name (30) or custom name (32), number, date and time information of a caller, but fails to teach or suggest a server having caller profiles with enhanced caller information that is accessible by subscribers, in addition to the standard caller information, as recited in each of Assignee’s independent claims 1, 18, 31 and 46. Gurbani disclose a system for storing

a log of calls containing standard name, number, date and time information that can be prioritized by a subscriber, but fails to teach or suggest providing enhanced caller information, in addition to the standard caller information, upon request of a subscriber, as recited in each of Assignee's independent claims. Thus, neither Moss, Gurbani, nor the combination thereof renders obvious the subject matter recited in at least Assignee's independent claims 1, 18, 31 and 46. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 11-17, 27-30, 41-46 and 55-62 based on the combination of Moss and Gurbani is respectfully requested.

### **Rejection of Claims under § 103(a) / Moss & Tannebaum References**

In Item 8 of the Office Action, claims 7, 9, 23, 25, 37, 39, 51 and 53 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Moss in view of U.S. Patent No. 5,901,209 to Tannebaum et al. (hereafter "Tannebaum"). The rejection is respectfully traversed.

### **Assignee's Claims**

Assignee's independent claims 1, 18, 31 and 46, from one of which all remaining claims ultimately depend, are set forth and discussed above.

### **Lack of Obviousness**

To establish a *prima facie* case of obviousness, three criteria must be met:

- I) the prior art must provide "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill";
- II) there must be a reasonable expectation of success; and
- III) all the claimed limitations must be taught or suggested by the prior art.

DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

Each of the above criteria are addressed in turn below, whereby the Assignee demonstrates that the combination of Moss and Tannebaum does not render obvious the Assignee's claimed subject matter as the combination does not teach, suggest, or otherwise provide motivation to produce the claimed subject matter. Further, the combination does not provide a reasonable expectation of success. Still further, the combination does not even disclose, teach, and/or suggest all of the claimed subject matter.

D) Moss is discussed in detail above and generally provides a caller identification system (20) that identifies specific caller names from a custom name database (32) if a pre-entered destination number within a common organization has been called. U.S. Patent No. 5,901,209, col. 2, lines 32-45. Otherwise, Moss identifies only the organization's name from a standard name database (30). Id., col. 2, lines 20-24. The destination numbers (24) are pre-entered into service switching point (22) in Moss and trigger queries, via service control point (26) to the appropriate name database (30) or custom name database (32) based on the destination numbers pre-entered into the service switching point (22). Id., col. 2, lines 20-24 and lines 32-45. Nothing in Moss teaches or suggests that the caller information provided from the standard name database (30) or the custom name database (32) includes enhanced caller information in addition to the standard information provided from such databases. As a result, Moss also necessarily fails to teach or suggest that a subscriber may request the retrieval of such enhanced caller information. Further, the custom name information in Moss is only available in response to a call to a destination number within a common organization, rather than through a server that is accessible, upon request, to subscribers outside a common organization, as is contemplated by Assignee's claims.

Tannebaum discloses a call management system (109) using a predictive dialer (110) through which an agent ("calling party") contacts a target ("called party").

Tannebaum expressly states however that “As each call is placed, the caller ID for the particular agent handling the call is replaced with a caller ID from a database.” *Id.*, col. 3, lines 8-10. Moreover, a third party user, such as a company or campaign organization, enters each agent’s information as well as each target’s information into the call management system (109) to supply the predictive dialer (110). *Id.*, col. 3, lines 15-23. Calls are thereafter made by the agents to the targets using the predictive dialer “according to the user’s desires.” *Id.*, col. 3, lines 54-58. The call management system of Tannebaum thus provides a method by which geographically dispersed agents may call targets for a common third party user, and call records of those calls are reported to the common third party user. *Id.*, col. 5, lines 2-5 and 49-52, and col. 6, lines 56-65. Thus, even if Tannebaum allowed an agent to be personally identified, Tannebaum does not teach, disclose or suggest that the agent enters any calling party information. Rather, the third party user enters such calling party information. *Id.*, col. 3, lines 15-23. Such is contrary to that recited in Assignee’s independent claims, wherein the caller profile information is entered to a server by the caller. Moreover, the calling information of Tannebaum is not optionally selectable by the target (“called party”), as is the enhanced calling information recited in Assignee’s independent claims.

Because neither Moss nor Tannebaum, individually or in combination, teaches or otherwise suggests enhanced caller information entered by a calling party, nor the accessing thereof at a subscriber’s (called party’s) request, then neither provides motivation to do so either. Accordingly, the combination of Moss and Tannebaum does not render obvious the subject matter of independent claims 1, 18, 31 and 46, from one of which claims 7, 9, 23, 25, 37, 39, 51 and 53 depend. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claims 7, 9, 23, 25, 37, 39, 51 and 53 based on the combination of Moss and Tannebaum is respectfully requested.

II) Because Moss limits the identification of caller information to standard name or custom name information only, then Moss teaches away from providing the enhanced calling information recited in Assignee’s independent claims. Likewise,

because Tannebaum limits the entry of calling party information to entry by a third party user, then Tannebaum teaches away from the entry of enhanced caller information by a caller and the provision thereof to a called party subscriber at the request of the subscriber, as cited in Assignee's independent claims.

"A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See*, MPEP at §2145 (X)(D)(1). "It is improper to combine references where the references teach away from their combination." *Id.* at § 2145 (X)(D)(2). If the proposed reference(s) changes the principle of operation of the prior art, then the teachings of the reference are not sufficient to support a *prima facie* case of obviousness. *Id.* at §2143.01.

Because Moss limits the identification of caller information to caller or custom caller name, number, date and time information rather than enhanced caller information, in addition to such standard caller information, and because Tannebaum requires entry of caller information by a third party, then there is no reasonable expectation of success of modifying Moss with Tannebaum to provide enhanced caller information that is entered by a caller and available to a called party subscriber upon the request of the subscriber. Simply stated, Moss nor Tannebaum discloses neither the entry of enhanced caller information by a calling party nor the option of retrieval of such enhanced caller information, in addition to standard caller information, at the called party's option. Thus, neither Moss nor Tannebaum provide any reasonable expectation that their systems or methods could successfully be modified singly, or in combination, to provide the combination of features recited in Assignee's independent claims, from which all remaining claims ultimately depend. In fact modifying either or both of Moss and Tannebaum to have a caller enter enhanced caller information would alter the principal operation of both references, as Moss limits its caller identification to name or custom name, number, date and time information and as Tannebaum does not even permit the calling agent to enter its caller information, but instead has a third party user enter the agent's calling information. Moreover modifying either of Moss or Tannebaum to allow a called party to optionally retrieve enhanced caller information would also alter the

principle operation of each of these references – that is, neither provide such enhanced caller information, and neither mention such an option for a called party.

Thus, the combination of Moss and Tannebaum does not render obvious the subject matter recited in at least Assignee's independent claims 1, 18, 31 and 46. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 7, 9, 23, 25, 37, 39, 51 and 53 based on the combination of Moss and Tannebaum is respectfully requested.

III) Moss discloses a caller identification system that identifies standard name (30) or custom name (32), number, date and time information of a caller, but fails to teach or suggest a server having caller profiles with enhanced caller information that is accessible by subscribers, in addition to the standard caller information, as cited in each of Assignee's independent claims 1, 18, 31 and 46. Tannebaum discloses a call management system with a predictive dialer into which a calling party's (agent's) calling information is entered, by a third party user, for eventual display to a target (called party). Tannebaum fails, however, to teach or suggest providing enhanced caller information that is entered by a caller and available to a called party, in addition to the standard caller information, upon request of the called party (subscriber), as set forth in the subject matter of each of Assignee's independent claims. Thus, neither Moss, Tannebaum, nor the combination thereof, render obvious the subject matter recited in at least Assignee's independent claims 1, 18, 31 and 46, from one of which claims 7, 9, 23, 25, 37, 39, 51 and 53 depend. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 7, 9, 23, 25, 37, 39, 51 and 53 based upon the combination of Moss and Tannebaum is respectfully requested.

**Rejection of Claims under § 103(a) / Moss & Bushnell References**

In Item 9 of the Office Action, claims 5, 6, 8, 10, 24, 26, 34, 35, 38, 40, 52 and 54 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Moss in view of U.S. Patent Application Publication No. 2002/0067816 to Bushnell (hereafter "Bushnell"). The rejection is respectfully traversed.